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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/738,023 | 12/15/2000 | Bryan Blair | 1-Step Surety System | 9285 |

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| EXAMINER |
|---|
| FRENEL, VANEL |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3626 | |

Arthur L. Plevy
Duane, Morris & Heckscher LLP
Suite 100
100 College Road West
Princeton, NJ 08540

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 09/738,023 | BLAIR ET AL. |
| | Examiner | Art Unit |
| | Vanel Frenel | 3626 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *15 December 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 12/15/00. Claims 1-22 are pending.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al (4,831,526) in view of Bosco et al (5,191,522).

(A) As per claim 1, Luchs discloses a method for issuing an insurance underwriting instrument using at least one computing processor, the system comprising:

storing underwriting data so as to be accessible by said at least one computer processor (Col.1, lines 63-68 to Col.2, line 18; Col.6, lines 13-68);

storing data indicative of insurance customers so as to be accessible by said at least one computer processor (Col.1, lines 63-68 to Col.2, line 18; Col.6, lines 13-68);

inputting data indicative of an insurance underwriting instrument to be issued and being associated with one of said customers (Col.5, lines 51-68 to Col.6, line 24);

automatically calculating a premium for the insurance underwriting instrument based on the input data and the underwriting data in response to a request therefore

(Col.7, lines 29-68 to Col.8; line 68; Col.9, lines 40-68);

and,

wherein data indicative of said insurance underwriting instrument is automatically stored so as to be accessible to said at least one processor (Col.1, lines 63-68 to Col.2, line 18; Col.6, lines 13-68).

Luchs does not specifically teaches automatically rendering the insurance underwriting instrument using said data indicative of said insurance customers and calculated premium payment in response to a request therefore.

However, this feature is known in the art, as evidenced by Bosco. In particular, Bosco suggests automatically rendering the insurance underwriting instrument using said data indicative of said insurance customers and calculated premium payment in response to a request therefore (See Bosco, Col.26, lines 63-68 to Col.27, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bosco within the system of Luchs with the motivation of providing a combination of specific stored program modules which are capable of inputting and processing data onto the single relational data base (See Bosco, Col.3, lines 40-45).

(B) As per claim 2, Luchs discloses the method wherein the insurance underwriting instrument is one of a fidelity policy and a surety bond (The Examiner interprets "umbrella" coverage as a form of fidelity policy See Luchs Col.8, lines 8-68 to Col.9, line 68).

(C) As per claim 3, Luchs discloses the method wherein said inputting comprises presenting at least one electronic document to a user via a browser functionality of software running on a microprocessor based device, and communicating data input to said software by said user to said at least one processor (Col.1, lines 63-68 to Col.2, line 18; Col.6, lines 13-68).

(D) As per claim 4, Luchs discloses the method further comprising automatically calculating a premium for at least one alternative insurance underwriting instrument having at least one characteristic differing from said insurance underwriting instrument (Col.11, lines 3-47; Col.13, lines 3-63).

(E) As per claim 5, Luchs discloses the method further comprising automatically storing said input data (Col.11, lines 3-33).

(F) As per claim 6, Luchs discloses the method further comprising: providing data indicative of images of a plurality of insurance underwriting instruments (Col.13, lines 30-68); wherein said rendering comprises selecting one of said instruments dependently upon said input data (Col.13, lines 30-68 to Col.14, line 36); and, uses at least a portion of said data indicative of images of said plurality of underwriting instruments being associated with said selected one of said instruments (Col.19, lines 22-68 to Col.20, line 68).

(G) As per claim 7, Luchs discloses a data processing system for issuing an insurance underwriting instrument, the system comprising:

a user interface for entering data indicative of insurance customers and requests for insurance policies and receiving data indicative of approved insurance underwriting instruments (Col.24, lines 1-68);

an application subsystem communicable with said user interface and for managing communications with the user interface (Col.15, lines 5-68);

a data management subsystem communicable with said business subsystem and for storing data indicative of images of said plurality of forms and data indicative of insurance policies (Col.1, lines 63-68 to Col.2, line 18; Col.6, lines 13-68).

Luchs does not explicitly disclose a business subsystem communicable with said application subsystem and for automatically calculating premium payments for said entered requests, automatically selecting ones of a plurality of forms in response to said entered data, and rendering said selected forms.

However, this feature is known in the art, as evidenced by Bosco. In particular, Bosco suggests a business subsystem communicable with said application subsystem and for automatically calculating premium payments for said entered requests, automatically selecting ones of a plurality of forms in response to said entered data, and rendering said selected forms (See Bosco, Col.23, lines 4-68 to Col.24, line 68; Col.26, lines 63-68 to Col.27, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bosco within the system of Luchs with the motivation of providing a combination of specific stored program modules which are capable of inputting and processing data onto the single relational data base (See Bosco, Col.3, lines 40-45).

(H) As per claim 8, Bosco discloses the system wherein said user interface comprises software for providing a browser functionality operable on a microprocessor based device (Col.23, lines 4-68).

The motivation for combining the respective teachings of Luchs and Bosco are as discussed above in the rejection of claim 7, and incorporated herein.

(I) As per claim 9, Bosco discloses the system wherein said user interface and application system are communicable with one another via a computer network (Col.23, lines 4-68).

The motivation for combining the respective teachings of Luchs and Bosco are as discussed above in the rejection of claim 7, and incorporated herein.

(J) As per claim 10, Bosco discloses the system wherein said microprocessor based device further comprises software for viewing and printing said approved insurance underwriting instruments (Col.22, lines 40-68 to Col.23, line 64).

The motivation for combining the respective teachings of Luchs and Bosco are as discussed above in the rejection of claim 7, and incorporated herein.

(K) As per claim 11, Bosco discloses the system wherein said application subsystem comprises at least one web server (Col.23, lines 4-17).

The motivation for combining the respective teachings of Luchs and Bosco are as discussed above in the rejection of claim 7, and incorporated herein.

(L) As per claim 12, Bosco discloses the system wherein said at least one web server includes software for providing user account management and providing e-mail services (Col.23, lines 4-64).

The motivation for combining the respective teachings of Luchs and Bosco are as discussed above in the rejection of claim 7, and incorporated herein.

(M) As per claim 13, Bosco discloses the system wherein said at least one server includes software validating said requests for insurance policies (Col.23, lines 4-68 to Col.24, line 43).

The motivation for combining the respective teachings of Luchs and Bosco are as discussed above in the rejection of claim 7, and incorporated herein.

(N) As per claim 14, Bosco discloses the system wherein the business subsystem comprises a transaction processor for transferring requests between the application subsystem and business subsystem (Col.23, lines 4-68 to Col.24, line 43).

The motivation for combining the respective teachings of Luchs and Bosco are as discussed above in the rejection of claim 7, and incorporated herein.

(O) As per claim 15, Bosco discloses the system wherein the business subsystem further comprises a first microprocessor based device for selecting ones of said plurality forms in response to said user interface, a second microprocessor based device for rendering said selected forms, a third microprocessor based device for automatically calculating premiums associated with said entered requests, and software for automatically renewing existing insurance policies (Fig.13, Col.3, lines 25-45).

The motivation for combining the respective teachings of Luchs and Bosco are as discussed above in the rejection of claim 7, and incorporated herein.

(P) As per claim 16, Bosco discloses the system wherein said first microprocessor-based device includes software for searching said forms (Col.23, lines 4-68 to Col.24, line 68).

The motivation for combining the respective teachings of Luchs and Bosco are as discussed above in the rejection of claim 7, and incorporated herein.

(Q) As per claim 17, Bosco discloses the system wherein said third microprocessor-based device includes software for rating policies to be issued. (Col.23, lines 4-68 to Col.24, line 43).

The motivation for combining the respective teachings of Luchs and Bosco are as discussed above in the rejection of claim 7, and incorporated herein.

(R) Claim 18 differs from claims 1 and 7 by reciting a data processing system for issuing an insurance underwriting instrument, the system comprising: at least one computer processor.

As per this limitation, it is noted that Luchs discloses a first query-able plurality of memory locations for storing data indicative of images of a plurality of forms, each of said forms being associated with a particular type of underwriting instrument (Col.13, lines 3-68 to Col.14, line 68);

a second query-able plurality of memory locations storing data indicative of policies (Col.13, lines 3-68 to Col.14, line 68);

at least one user interface for inputting data indicative of an insurance client and data indicative of the underwriting instrument (Col.13, lines 3-68 to Col.14, line 68) and Bosco discloses at least one calculator application responsive to said user interface and for automatically calculating a premium for the insurance underwriting instrument based on the input data using said at least one computer processor and data indicative of underwriting policies See Bosco, Col.23, lines 4-68 to Col.24, line 68; Col.26, lines 63-68 to Col.27, line 52).

Thus, it is readily apparent that these prior art system utilize a data processing system for issuing an insurance underwriting instrument, the system comprising: at least one computer processor to perform their specified function.

The remainder of claim 18 is rejected for the same reason given above for claims 1 and 7, and incorporated herein.

(S) As per claim 19, Bosco discloses the system further comprising software for rendering a suitable one of said plurality of forms using said data stored in said first and second pluralities of memory locations and calculated premium in response to a request from said user interface (Fig.11; Col.19, lines 33-68).

(T) As per claim 20, Luchs discloses the data processing system wherein the insurance underwriting instrument is one of a fidelity policy and as a surety bond (The Examiner interprets "umbrella" coverage as a form of fidelity policy See Luchs Col.8, lines 8-68 to Col.9, line 68).

(U) As per claim 21, Luchs discloses a method for issuing an insurance underwriting instrument using at least one computing processor, the method comprising:

identifying data stored in a plurality of memory locations and being indicative of a select one of a plurality of customers (Col.13, lines 3-68 to Col.14, line 68);

receiving data indicative of an insurance instrument to be associated with said select customer (Col.14, lines 24-68 to Col.15, line 62);

automatically calculating at least one rate associated with said insurance instrument using said data indicative of said customer and data indicative of said insurance instrument (Col.7, lines 29-68 to Col.8; line 68; Col.9, lines 40-68);

selecting at least one of a plurality of forms for said insurance instrument using said data indicative of said insurance instrument (Col.1, lines 63-68 to Col.2, line 18; Col.6, lines 13-68); and,

automatically rendering said at least one form using said at least one rate, said data indicative of said customer, and data indicative of said insurance instrument (Col.7, lines 29-68 to Col.8; line 68; Col.9, lines 40-68).

Luchs does not explicitly disclose wherein, said calculating and rendering are performed using said at least one computing processor.

However, this feature is known in the art, as evidenced by Bosco. In particular, Bosco suggests wherein, said calculating and rendering are performed using said at least one computing processor (See Bosco, Col.26, lines 63-68 to Col.27, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bosco within the system of Luchs with the motivation of providing a combination of specific stored program modules which are capable of inputting and processing data onto the single relational data base (See Bosco, Col.3, lines 40-45).

(V) As per claim 22, Luchs discloses the method wherein the insurance underwriting instrument is one of a fidelity policy and as a surety bond (The Examiner interprets

"umbrella" coverage as a form of fidelity policy See Luchs Col.8, lines 8-68 to Col.9, line 68).

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches underwriting insurance (20020111835), system and method for enabling real time underwriting of insurance policies (20020087364) and method and computerized system for managing insurance receivable accounts (5,991,733).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
V.F
June 22, 2004

Alexander Kalinowski
Alexander Kalinowski
Au 3626
Primary Examiner